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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/112,774	07/10/1998	KIA SILVERBROOK	IR18US	7296

7590

09/18/2002

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EXAMINER

YE, LIN

ART UNIT PAPER NUMBER

2612

DATE MAILED: 09/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/112,774

Applicant(s)

SILVERBROOK, KIA

Examiner

Lin Ye

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 7/8/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

1. The substitute specification filed 7/8/02 has not been entered because it does not conform to 37 CFR 1.125(b) because:

The lengthy listing of "related" applications does not add anything of value to the specification. Oppositely, the listing creates confusion in that it is not clear what, if anything, each is meant to add to the disclosure. The applicant is free to submit the listing as an information disclosure statement or as an appendix. It is important to note that, absent specific discussion as to the relevance of the cited applications, the documents **have not** been considered by the Examiner.

Response to Arguments

2. Applicant's arguments filed 7/8/02 have been fully considered but they are not persuasive as to claims 1-4.

Relative to claims 1-4, the Applicant argues that Cane does not disclose a "guillotine mechanism" which is powered by a portable power supply nor does it disclose a guillotine mechanism located between the print media supply means and the print head. The Examiner disagrees. As shown in Figure 26(b), the Cane reference discloses a "guillotine mechanism" (cassette 350 includes an actuate row of cutting teeth 352 or a slidable cutting blade for cutting the paper) is located between the print media supply (a paper cassette includes upper portion 350 and insert into print head 308) means and the print head (308) (See Col. 15, lines

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54-67, and Col. 16, lines 1-18). As shown in Figure 6, the print head (135) is powered by the portable power supply (battery 141). Since the "guillotine mechanism" (350) is included in the print assembly, it can be considered as powered by a portable power supply with print head.

Relative to claims 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,152,619 (Hereinafter referred to as '619). The Applicant request such evidence be supplied. It should be noted that as in Figures 8, both the '619 and the Applicant discloses a "guillotine mechanisms" (63) includes "worm screw" (64) and "worm gear" (67) which includes a cutting wheel (68). Since both have same elements includes in Figure 8, this can be considered as a worm screw and worm gear is equivalent to the claimed "guillotine mechanisms" in claim 1. In other words, the current claim is a broadly recitation of '619 claim 1. Were it to be allowed to issue, it would result in an unjustified time- wise extension of the monopoly created by the '619 patent.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Cane et al U.S. Patent 5,999,203 (Hereinafter referred to as Cane).

Referring to claim 1, the Cane reference discloses in Figures 1, 4, 6, 18 and 26(a, b, c) an electronic imaging camera includes a printer assembly for providing instant images. A microprocessor (4) processes sensed image and controls printer head (5) to print stored image from camera system (See Col 4, lines 12-22). A portable battery (141) connected print and camera system as shown in Figure 6. The printer assembly includes a print head (308) and a paper advance roller (318) as shown in Figure 18. A replaceable preloaded paper cartridge is provided for easy replacement of the paper. A guillotine mechanism (350) located between print-sheet roll (318) and print head (308) to cut print sheet to a predetermined size as shown in Figure 26b (See Col 15, lines 54-64 and Col. 16, lines 1-18)). In Figure 6, the print head (135) is powered by the portable power supply (battery 141). Since the "guillotine mechanism" (350) is included in the print assembly, it can be considered as powered by a portable power supply with print head.

Referring to claims 2, 3 and 4, the guillotine mechanism (350) is detachable from camera system and attached to print cassette (350) below print head (308) (See Col 15, lines 35-52).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 1 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,152,619 (Hereinafter referred to as '619). Although the conflicting claims are not identical, they are not patentably distinct from each other because the reasons set forth below:

Both claims include an "image sensor" and a "print head". Additionally '619 includes a print media. Although claim 1 does not state that the print media is in roll form. It would have been obvious since the print media requires cutting. Although '619 claims a worm screw and worm gear, it is noted that this is equivalent to the claimed "guillotine mechanisms" in claim 1. Lately claim 1 includes a "portable power supply" which is not claimed in '619. It would have been obvious to include a portable power supply in the device claimed in '619 to that the camera need not be plugged in during use.

Conclusion

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lin Ye** whose telephone number is **(703) 305-3250**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy R Garber can be reached on (703) 305-4929.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks


Washington, DC. 20231

Or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


WENDY R. GARBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Lin Ye
September 9, 2002